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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT PAPER NUMBER

1712

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,394

Applicant(s)

MERTZ ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kerr et al. (WO 98/28376). Regarding claims 1-3, Kerr et al. disclose a release liner comprising a substrate having opposing surfaces, and a radiation cured silicone release coating in an organic solvent, absent a crosslinkable silicone hydride resin on a surface thereof (pages 17 and 18, Comparative Example 1), the coating comprising amounts of less than 5.0% occurring (page 17, lines 8-13). Although Kerr et al. do not appear to specifically disclose no more than about 1.5 micrograms per square centimeter of total extractables, this appears to be inherently disclosed because the same silicone composition (applicant's specification, page 6, lines 3-7), and curing temperature (applicant's Examples) as disclosed by applicant are disclosed by Kerr et al. in a working example (pages 17 and 18, Comparative Example 1) and curing temperature (page 15, lines 25-28), and the same materials and process step would have inherently yielded the same properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention

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was made for the composition of Kerr et al. to have achieved at least a similar amount of extractables because the materials and curing temperature of Kerr et al. are at least similar to those of Applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 4 and 5, Kerr et al. disclose that the composition can be solvent free (page 16, lines 1-5), which would appear to yield a volatile-free coating. Further, because the coating of Kerr et al. is the same as disclosed by applicant, this appears to be inherently disclosed (as set forth above).

Regarding claim 6, Kerr et al. do not appear to specifically disclose substantially no transfer of uncured silicone to adjacent surfaces. However, because the materials and curing temperature of Kerr et al. are the same as applicant's, it appears that this is an inherent property because the same materials and curing temperature would have inherently yielded a coating with the same inherent properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the coating of Kerr et al. to have achieved at least substantially no transfer of uncured silicone to adjacent surfaces because the materials and curing temperature of Kerr et al. are at least similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 7 and 8, Kerr et al. disclose a second release coating, with the coating of Kerr et al. being placed on another surface (page 16, lines 17-23).

Regarding claims 9-11, Kerr et al. disclose the instantly claimed substrates (page 22, lines 7-11).

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. (5,753,346).

Regarding claims 1-3, Leir et al. disclose a release liner comprising a substrate having opposing surfaces, and a radiation cured silicone release coating in an organic solvent, absent a crosslinkable silicone hydride resin on a surface thereof (col.12, Examples 1-28). Although Leir et al. do not appear to specifically disclose no more than about 1.5 micrograms per square centimeter of total extractables, this appears to be inherently disclosed because the same silicone composition as claimed by applicant, and curing temperature (applicant's Examples) as disclosed by applicant are disclosed by Leir et al. in a working example (pages 17 and 18, Comparative Example 1) and the same materials and process step would have inherently yielded the same properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Leir et al. to have achieved at least a similar amount of extractables because the materials and curing temperature of Leir et al. are at least

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similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 4 and 5, Leir et al. disclose that the solvent is evaporated from the coating (col.12, Examples 1-28), which would appear to yield a volatile-free coating. Further, because the coating of Leir et al. is the same as claimed by applicant, this appears to be inherently disclosed (as set forth above).

Regarding claim 6, Leir et al. do not appear to specifically disclose substantially no transfer of uncured silicone to adjacent surfaces. However, because the materials and curing temperature of Leir et al. are the same as that claimed by applicant, it appears that this is an inherent property because the same materials and curing temperature would have inherently yielded a coating with the same inherent properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the coating of Leir et al. to have achieved at least substantially no transfer of uncured silicone to adjacent surfaces because the materials and curing temperature of Leir et al. are at least similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 9-11, Leir et al. disclose the instantly claimed substrates (col.9, line 54-col.10, line 20).

Claim Rejections - 35 USC § 103

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leir et al. (5,753,346). Leir et al., as applied above, are as set forth and incorporated herein. Leir et al. do not appear to specifically disclose a second release coating on the opposite side of the substrate. However, the repetition of steps to provide the same results is within the skill of one having ordinary skill in the art. The concept of duplication is not patentable. *St. Regis Paper Co. v. Bemis Co. Inc.*, 193 USPQ 8, 11 (7th Cir. 1977). While this decision relates to the duplication of parts, there is no reason why such duplication cannot be extended to a process step.

Response to Amendment

The amendment under 37 CFR 1.132 filed 5/2/05 is insufficient to overcome the rejection of claims 1-11 as set forth in the previous office action for the following reasons. Applicant has disclosed (paragraph 6 of the declaration) that Kerr et al. comprise compositions with epoxyorganosiloxane and a cross-linkable silicone hydride resin with no epoxy functionality and a curing agent, as noted in the last office action, Kerr et al. disclose a working example with the same materials as that of applicant (Comparative Example 1, pages 17 and 18), which does not contain a silicone hydride resin. Applicant has also set forth (paragraph 7 of the declaration) that the composition of Kerr et al. cannot result in a reduced amount of total silicone extractables, but the claims are not directed to total silicone extractables, but rather total extractables. If Kerr et al. can encompass no solvent, then why wouldn't the composition have less than about 1.5 micrograms per square centimeter total extractables, assuming that solvents

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can be extractables? Finally, applicant has set forth (paragraph 8 of the declaration) that Example 6 shows that a solvent-free coating does not inherently result in a volatile-free coating. Table 6 shows Sample C with 57 nanograms/square centimeter and Sample D with 32 nanograms/square centimeter. Applicant then compares these results with control Sample E, which has 474 nanograms/square centimeter which applicant states is the same as Kerr et al.'s Example 1. However, for Example E, there are no ingredients or amounts listed, so it is unclear how it can be compared to Kerr et al.'s Example 1. Further, Sample E does not contain solvent, while Kerr et al.'s Example 1 clearly comprises solvent (bottom of page 17). Therefore, it is unclear how applicant can draw a comparison between this example and their own Sample E.

Applicant has not directly compared the composition of Kerr et al. and the claimed composition to show that the level of total extractables of Kerr et al. does not fall in applicant's claimed range. Further, the declaration did not address Leir et al.

Response to Arguments

Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. To begin, applicant argues the inherency rejection as set forth in the last office action. As set forth in the previous office action, Kerr et al. teach the same siloxane in organic solvent, absent a crosslinkable silicone hydride resin, with the composition having amounts of extractables of less than 5.0% occurring, and that the curing temperatures can be included in the range as used by applicant. The composition of Kerr et al. as cited by the examiner does not require the silicone hydride

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resin compound as applicant asserts. As the materials and curing temperature of Kerr et al. are the same as applicant's, it appears that the total extractable is an inherent property because the same materials and curing temperature would have inherently yielded a coating with the same inherent properties, absent evidence to the contrary.

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Applicant has argued that the composition of Kerr et al. requires it to be solvent free, but as shown in Comparative Example 1, solvent is present.

Finally, applicant has argued that Samples C, D, and E of the instant application distinguish themselves from Sample E, which applicant compares to Example 1 of Kerr et al., but as set forth above, it does not seem possible to compare Sample E to anything as it does not list any ingredients or amounts.

Regarding applicant's arguments concerning the rejection over Leir et al., applicant has argued that Leir et al. do not meet the inherency standard. The same reasoning for this rejection, as set forth above for Kerr et al., also applies to Leir et al.

Applicant has argued that Leir et al. do not teach or suggest curing temperatures used by applicant. However, Leir et al. clearly set forth 65°C as a curing temperature for the silicone composition (col.12, lines 30-31), which equates to 149°F, while applicant shows a curing temperature of 158°F in Examples 3 and 5, and no specific curing temperature in Example 4. Further, applicant discloses in the specification (page 7, last paragraph) that drying temperatures can be from about 100 to about 325°F, and that temperatures outside this range can be used as well. This appears to read on Leir et al.

Finally, applicant has argued that Leir et al. do not disclose the need for a release liner having significantly reduced amounts of total extractables and/or volatile organic compounds, and that Leir et al. do not disclose a thermal pretreatment step. However, applicant has claimed a silicone composition with an amount of total extractables of no more than about 1.5 micrograms/square centimeter. Applicant has not claimed a pretreatment step, curing temperature, total silicone extractables, nor has applicant provided a direct comparison between the compositions of Kerr et al. and Leir et al. to the claimed composition.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan



DAVID J. BUTTNER
PRIMARY EXAMINER

July 5, 2005

